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Signature

April 18, 2008
Date of Signature

PATENT
Case No. AUS920010440US1
(9000/43)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:)	
)	
RABINDRANATH DUTTA)	Examiner: DASS, H. T.
)	
Serial No.: 09/915,439)	
)	Group Art Unit: 3692
Filed: JULY 26, 2001)	
)	Conf. No.: 7368
Title: METHOD FOR PROVIDING)	
ANONYMOUS ON-LINE)	
TRANSACTIONS)	

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22202-1450

Dear Sir:

Appellants respectfully present their Brief on Appeal as follows:

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1. REAL PARTY IN INTEREST

The real party in interest is assignee INTERNATIONAL BUSINESS MACHINES CORPORATION, a corporation organized and existing under the laws of the State of New York, USA and located at New Orchard Road, Armonk, New York 10504, USA

2. RELATED APPEALS AND INTERFERENCES

Appellant and the undersigned attorneys are not aware of any appeals or any interferences which will directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS

Claims 1 -25 are currently pending in the application and stand finally rejected under 35 U.S.C. §103(a) as unpatentable over *Hambrecht* in view of *Kiselik* in view of *Herschkorn*. All claims are on appeal. See, the Appendix.

4. STATUS OF AMENDMENTS

All amendments have been entered in the application.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1:

Independent claim 1 recites a method for performing an anonymous online transaction. The method includes receiving 220 a request for an enhanced certificate from a requestor at a certificate authority server 40 and determining 235 whether the requestor qualifies for the enhanced certificate 70. The method further includes issuing 240 the requestor an enhanced certificate 70 from the certificate authority server 40 if the requestor qualifies, receiving 380 an offer from a supplier with a supplier enhanced certificate 70 at an aggregate exchange server 50, and receiving a bid from a purchaser with a purchaser enhanced certificate 70 at the aggregate exchange server 50. Further, the method includes determining 390 whether the bid matches the offer, sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and sending 400 the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer, and receiving 410 agreement of the matched supplier and purchaser at the exchange server 50 to execute the anonymous transaction. See, for example, FIGS. 1, 2, 8 and 9 as well as page 5, line 1 to page 12, line 30 of the specification.

Independent Claim 11:

Independent claim 11 recites a computer usable medium including a program for performing an anonymous online transaction. The medium includes computer readable code for receiving 220 a request for an enhanced certificate from a requestor at a certificate

authority server 40 and computer readable code for determining 235 whether the requestor qualifies for the enhanced certificate 70. The medium further includes computer readable code for issuing 240 the requestor an enhanced certificate 70 from the certificate authority server 40 if the requestor qualifies, computer readable code for receiving 380 an offer from a supplier with a supplier enhanced certificate 70 at an aggregate exchange server 50, and computer readable code for receiving a bid from a purchaser with a purchaser enhanced certificate 70 at the aggregate exchange server 50. Further, the medium includes computer readable code for determining 390 whether the bid matches the offer, computer readable code for sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and computer readable code for sending 400 the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer, and computer readable code for receiving 410 agreement of the matched supplier and purchaser at the exchange server 50 to execute the anonymous transaction. See, for example, FIGS. 1, 2, 8 and 9 as well as page 5, line 1 to page 12, line 30 of the specification.

Independent Claim 21:

Independent claim 21 recites a system for performing an anonymous online transaction. The medium includes means for receiving 220 a request for an enhanced certificate from a requestor at a certificate authority server 40 and means for determining 235 whether the requestor qualifies for the enhanced certificate 70. The medium further includes means for issuing 240 the requestor an enhanced certificate 70 from the certificate authority

server 40 if the requestor qualifies, means for receiving 380 an offer from a supplier with a supplier enhanced certificate 70 at an aggregate exchange server 50, and means for receiving a bid from a purchaser with a purchaser enhanced certificate 70 at the aggregate exchange server 50. Further, the medium includes means for determining 390 whether the bid matches the offer, means for sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and means for sending 400 the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer, and means for receiving 410 agreement of the matched supplier and purchaser at the exchange server 50 to execute the anonymous transaction. See, for example, FIGS. 1, 2, 8 and 9 as well as page 5, line 1 to page 12, line 30 of the specification.

6. **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-25 were rejected as unpatentable under 35 U.S.C. §103(a) as unpatentable over *Hambrecht*, 6,629,082 in view of *Kiselik*, 200/10034631, in view of *Herschkorn*, 6,691,094.

7. **ARGUMENTS**

The rejection of claims 1-25 as unpatentable under 35 U.S.C §103(a) over *Hambrecht* in view of *Kiselik* in view of *Hershkorn* is traversed. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The combination of *Hambrecht* and *Kiselik* and *Herschhorn* fails to teach or suggest each and every element of the claims, and therefore the §103(a) rejection fails.

Section 103 only “forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Specifically, the references alone or in combination fail to teach or suggest “receiving agreement of the matched supplier and purchaser at the exchange server to execute the anonymous transaction” as claimed in claims 1, 11 and 21 and neither *Hambrecht* nor *Kiselik* teach the benefits of keeping a transaction anonymous. Instead, both *Hambrecht* and *Kiselik* teach that anonymity harms the transaction. In contrast, several benefits of anonymity are

described in the background of the instant application, such as on pages 1 and 2 of the specification.

Indeed, *Kiselik* unequivocally teaches away from an anonymous transaction, by noting the benefits of requiring a “rating by the requester of the performance of the satisfier and a rating by the satisfier of the performance of the requester are entered into the computer system for continuous updating of performance ratings.” (Abstract, *Kiselik*). The dangers of exactly such a system are described in the instant specification on page 2, lines 1-11 – an unscrupulous purchaser or supplier can enter into a legitimate transaction to glean their business partner’s identity and then use that identity to flood an exchange with dummy orders to manipulate market position. Therefore it is incontrovertible that *Kiselik* teaches away from use of an anonymous transaction as claimed – the feedback mechanism precludes true anonymity.

Hambrecht does not cure this defect of *Kiselik*. In fact, *Hambrecht* further teaches away from the instant claims. While *Hambrecht* does not explicitly teach that the entity being formed with the capital formation needs to know the identity of the investors, *Hambrecht* clearly teaches that one practicing the invention needs to know the identity of the entity being formed. For example, see the abstract:

Techniques are provided for an auction system that is used for pricing and allocating equity securities. Information about an offering to accept bids for equity shares is provided to qualified potential purchasers and non-qualified potential purchasers. Bids from potential purchasers for equity shares

Furthermore, *Hambrecht* implicitly requires that the issuer must know the identity of the purchaser. Without such knowledge the issuer would not be able to pay dividends, for example.

In *KSR*, the Supreme Court reiterated that claims should be held patentable where even though the elements were known in the prior art, the fact that they work together in an unexpected manner renders the claims not obvious. Here, the fact that the prior art teaches the desirability of a user rating system is unequivocal. Such a teaching can only teach away from the desirability of anonymous transactions. The Examiner's attempt to avoid these clear 'teachings away' by adding *Herschkorn* and alleging a teaching of 'anonymity' does not cure these defects. The fact that an anonymous transaction, as claimed, works in an unexpected manner renders these claims not obvious. In other words, simply adding a reference that teaches 'anonymity' does not cure the fact that the rest of the references directly and unequivocally teach away from 'anonymity.'

These claims are perhaps most similar to the *Adams* case discussed in *KSR*. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1395 (emphasis added). In that matter, Adams designed a battery using certain types of electrodes, but the prior art warned that risks were involved in using the same certain types of electrodes. In *Adams*, and as affirmatively commented by the Supreme Court, the fact that the elements worked together in an unexpected and fruitful manner supported the conclusion that the design was not obvious to those skilled in the art.

Similarly, in this matter, anonymity was known prior to these claims, but the prior art taught that anonymity was to be avoided in commercial transactions – as specifically illustrated by *Hambrecht* and *Kiselik*. The fact that anonymity can be beneficial is unexpected and fruitful in that the disadvantages of the prior art can be avoided. The prior art teaches away from these claims, and specifically teaches away from a method for performing an anonymous online transaction as claimed, and therefore this rejection must fall.

Simply put, the Examiner cannot conclusively assert that the subject matter of providing an anonymous online transaction, as claimed, would be obvious at the time of the invention in light of prior art that teaches that there are many benefits to a non-anonymous transaction. Any such assertion can only be considered impermissible hindsight.

Claims 2-10, 12-20 and 22-25 depend directly or indirectly from one of claims 1, 11, or 21, and are therefore patentable over the references for at least the same reasons.

Withdrawal of the rejections to claims 1-25 is requested.

CONCLUSION

The Appellants respectfully submit that claims 1-16 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **APRIL 18, 2008**

Respectfully submitted,
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9. CLAIMS APPENDIX

1. A method for performing an anonymous online transaction comprising:
receiving a request for an enhanced certificate from a requestor at a certificate authority server;
determining whether the requestor qualifies for the enhanced certificate;
issuing the requestor an enhanced certificate from the certificate authority server if the requestor qualifies;
receiving an offer from a supplier with a supplier enhanced certificate at an aggregate exchange server;
receiving a bid from a purchaser with a purchaser enhanced certificate at the aggregate exchange server;
determining whether the bid matches the offer;
sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and sending the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer; and
receiving agreement of the matched supplier and purchaser at the exchange server to execute the anonymous transaction.
2. The method of claim 1 wherein the certificate authority server comprises the aggregate exchange server.
3. The method of claim 1 wherein the enhanced certificate comprises financial data, credit rating data, financial routing data and identification data.
4. The method of claim 1 wherein issuing the requestor an enhanced certificate comprises implementing at least one security feature.

5. The method of claim 4 wherein the security feature is selected from a group consisting of a user password, a public key cryptograph, a digital signature, and an XML based security standard.

6. The method of claim 1 further comprising:
providing a hyperlink to the aggregated exchange server wherein the hyperlink comprises the certificate request.

7. The method of claim 6 wherein the hyperlink is provided on a web site for access by the requestor.

8. The method of claim 1 further comprising:
verifying a portion of requestor financial information with an outside server.

9. The method of claim 8 wherein verifying the portion of requestor financial information comprises determining eligibility for an enhanced certificate.

10. The method of claim 8 further comprising:
updating requestor financial information.

11. A computer usable medium including a program for performing an anonymous online transaction comprising:

- computer readable code for receiving a request for an enhanced certificate from a requestor at a certificate authority server;
- computer readable code for determining whether the requestor qualifies for the enhanced certificate;
- computer readable code for issuing the requestor an enhanced certificate from the certificate authority server if the requestor qualifies;
- computer readable code for receiving an offer from a supplier with a supplier enhanced certificate at an aggregate exchange server;
- computer readable code for receiving a bid from a purchaser with a purchaser enhanced certificate at the aggregate exchange server;
- computer readable code for determining whether the bid matches the offer;
- computer readable code for sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and sending the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer; and
- computer readable code for receiving agreement of the matched supplier and purchaser at the exchange server to execute the anonymous transaction.

12. The computer usable medium of claim 11 wherein the certificate authority server comprises the aggregate exchange server.

13. The computer usable medium of claim 11 wherein the enhanced certificate comprises financial data, credit rating data, financial routing data and identification data.

14. The computer usable medium of claim 11 wherein issuing the requestor an enhanced certificate comprises implementing at least one security feature.

15. The computer usable medium of claim 14 wherein the security feature is selected from a group consisting of a user password, a public key cryptograph, a digital signature, and an XML based security standard.

16. The computer usable medium of claim 11 further comprising:
computer readable code for providing a hyperlink to the aggregated exchange server wherein the hyperlink comprises the certificate request.

17. The computer usable medium of claim 16 wherein the hyperlink is provided on a web site for access by the requestor.

18. The computer usable medium of claim 11 further comprising:
computer readable code for verifying a portion of requestor financial information with an outside server.

19. The computer usable medium of claim 18 wherein verifying the portion of requestor financial information comprises determining eligibility for an enhanced certificate.

20. The computer usable medium of claim 18 further comprising:
computer readable code for updating requestor financial information.

21. A system for performing an anonymous online transaction comprising:
 - means for receiving a request for an enhanced certificate from a requestor at a certificate authority server;
 - means for determining whether the requestor qualifies for the enhanced certificate;
 - means for issuing the requestor an enhanced certificate from the certificate authority server if the requestor qualifies;
 - means for receiving an offer from a supplier with a supplier enhanced certificate at an aggregate exchange server;
 - means for receiving a bid from a purchaser with a purchaser enhanced certificate at the aggregate exchange server;
 - means for determining whether the bid matches the offer;
 - means for sending the supplier the purchaser enhanced certificate from the aggregate exchange server, and means for sending the purchaser the supplier enhanced certificate from the exchange server, if the bid matches the offer; and
 - means for receiving agreement of the matched supplier and purchaser at the exchange server to execute the anonymous transaction.
22. The system of claim 21 further comprising:
 - means for implementing at least one security feature.
23. The system of claim 21 further comprising:
 - means for providing a hyperlink to the aggregated exchange server.

24. The system of claim 21 further comprising:
means for verifying a portion of requestor financial information with an
outside server.

25. The system of claim 24 further comprising:
means for updating requestor financial information.

10 EVIDENCE APPENDIX

Appellants entered no evidence pursuant to §1.130, 1.131 or 1.132, and the Examiner entered no evidence that was relied upon by Appellants.

11. RELATED PROCEEDINGS APPENDIX

There are no copies of related decisions or proceedings.